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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,062

02/17/2004

Calvin Lam

C&M1.PAU.19

9669

23386

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12/04/2006

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/780,062

Applicant(s)

LAM, CALVIN

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action, or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***35 USC 112 Rejections***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims define a finished wood slat made from rejoining multiple slats and cutting the rejoined slats along a direction perpendicular to a face plane of the slats such that "the form lines" are exposed and appear to be side-by-side and extend throughout the length. However, the claims later detail that the joining marks are hidden. It is not clear how the form lines or joining marks are exposed but yet are hidden. Further, it is not clear how, if there exists markings (32) on the slat (figure 9), and the slat is cut along a plane that is parallel to the Y-Z axis (which is understood to lie parallel to the horizontal), how the markings will be hidden. The markings (32) appear to extend perpendicular to the Y-Z axis. If this is true, when the slat (40) is cut horizontally (parallel to the Y-Z axis) therealong, a certain portion of the marking (32) will still be viewable from at least the selected thickness of the cut. Also, Figure 10 appears to show (although not identified in the drawings or in the specification) some sort of markings. Clarification is required.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3,8,9,14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 8, it is not clear how the slats have exposed joining lines that are hidden. Clarification is required.

In claims 8,9,14 and 15, it is not clear if reference of the markings and the rectangular shape are directed to the new bulk section or the original bulk section. Until further clarification, the claims have been examined as the new bulk section as having the markings. Clarification is required.

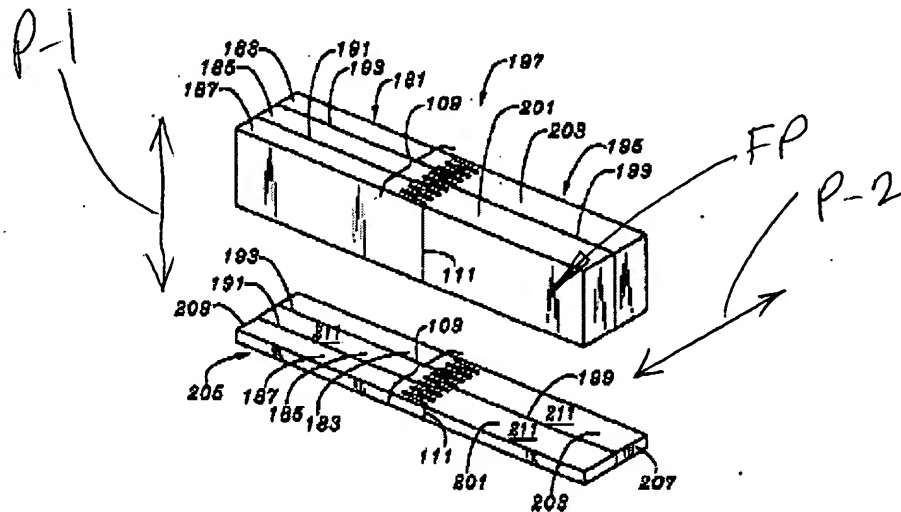
*Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #6,763,873 to LEE.

Regarding claim 1, LEE discloses the use of a finished wood slat (205) including separate multiple first slats (183,185,187,201,203) having a first length and laminated together to form form lines (191,193,199) that extend along the first length; wherein the laminated multiple first slats (183,185,187,201,203) are cut along a direction

perpendicular to a face plane (FP) to form a second length (205) and to expose the form lines (191,191,199) such that they appear side-by-side throughout the second length.



Regarding claim 2, LEE discloses the use of a finished wood slat (205) including a first end (207), an opposite end (209), and a long thin rectangular shape have a wood grain that extends therebetween; wherein the wood grain resulting from periphery edges (as at 191,193,199) of a plurality of first separate slats (183,185,187,201,203) combined together. In reference to claim 3, the joining marks (191,193,199) are hidden by the covering (225). Regarding claims 4 and 5, the plurality of first slats are laminated (225) and bonded with an adhesive (83). In reference to claim 6, the plurality of first slats (183,185,187,201,203) are selectively cut to preferred dimensions. Regarding claim 18, the wood grain includes a plurality of parallel horizontal lines (191,193,199) extending between the first end (207) and the second end (209).

Regarding claims 7 and 13, LEE discloses the method of making a wood slat (205) including the steps of providing a bulk wood section, column 9 lines 24-30; cutting successive separate sections (183,185,187,201,203) in a desired shape along a first plane (P-1); rejoining the sections (183,185,187,201,203), in a different order )there being three slat on the left and two slats on the right ) as at (191,193,199) to form a new bulk section, (197); and cutting a second set of successive sections along a second plane (P-2) that is perpendicular to the first plane (P-1) thereby forming a plurality of finished slats (91). In reference to claims 8,10 and 15 the bulk sections (197) are rectangular, have joining marks (191,193,199), and the method includes a process of covering (as at 225) to hide any markings, column 6, line 37. Regarding claims 11,12,16 and 17, the wood slats (205) are thin rectangular shapes. In reference to claim19, the wood grain includes a plurality of parallel horizontal lines (191,193,199) exposed in a side-by-side manner throughout the length of each slat (205).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,763,873 to LEE. In reference to claims 9 and 14, LEE discloses the basic claimed wood slat except for explicitly detailing the use of markings. Although LEE is silent in this regard, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to provide the rejoined pieces with markings in order to proper guide the cutter to thereby have accurate finished slats of the same dimensions. The applicant is further reminded that marking products, specifically wood products prior to cutting is old and very well known in the art.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the newly revised ground(s) of rejection.

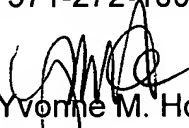
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yvonne M. Horton  
Examiner  
Art Unit 3635

11/30/06